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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,970	01/24/2001	Olga Bandman	PF-0321-2 DIV	7462

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EXAMINER	
CARLSON, KAREN C	
ART UNIT	**PAPER NUMBER**
1653	5

DATE MAILED: 07/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/769,970	BANDMAN ET AL.	
	Examiner	Art Unit	
	Karen Cochrane Carlson, Ph.D.	1653	

-- The MAILING DATE of this communication appears on th cover sheet with th correspond nce address --

Period f r Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-21* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Restriction to one of the following inventions is required under 35 U.S.C. 121:

SET 1:

1. Claims 1-7, drawn to polynucleotide encoding DAPK-1 (SEQ ID NO: 1), classified in class 536, subclass 23.2.
2. Claims 1-7, drawn to polynucleotide encoding DAPK-2 (SEQ ID NO: 2), classified in class 536, subclass 23.2.
3. Claims 1-7, drawn to polynucleotide encoding DAPK-4 (SEQ ID NO: 4), classified in class 536, subclass 23.2.
4. Claims 1-7, drawn to polynucleotide encoding DAPK-5 (SEQ ID NO: 5), classified in class 536, subclass 23.2.
5. Claims 1-7, drawn to polynucleotide encoding DAPK-6 (SEQ ID NO: 6), classified in class 536, subclass 23.2.
6. Claims 1-7, drawn to polynucleotide encoding DAPK-7 (SEQ ID NO: 7), classified in class 536, subclass 23.2.

Inventions 1-6 are drawn to polynucleotides encoding diseases associated kinases having different structures. Therefore, each DAPK is patentably distinct one from the other. If any one of Inventions 1-6 is elected, the examination of the claims will be carried out only in-so-far as the claims are drawn to the elected subject matter.

SET 2:

7. Claims 8-10, drawn to a method for detecting polynucleotides via polynucleotide encoding DAPK-1 (SEQ ID NO: 1), classified in class 435, subclass 6.
8. Claims 8-10, drawn to a method for detecting polynucleotides via polynucleotide encoding DAPK-2 (SEQ ID NO: 2), classified in class 435, subclass 6.

9. Claims 8-10, drawn to a method for detecting polynucleotides via polynucleotide encoding DAPK-4 (SEQ ID NO: 4), classified in class 435, subclass 6.

10. Claims 8-10, drawn to a method for detecting polynucleotides via polynucleotide encoding DAPK-5 (SEQ ID NO: 5), classified in class 435, subclass 6.

11. Claims 8-10, drawn to a method for detecting polynucleotides via polynucleotide encoding DAPK-6 (SEQ ID NO: 6), classified in class 435, subclass 6.

12. Claims 8-10, drawn to a method for detecting polynucleotides via polynucleotide encoding DAPK-7 (SEQ ID NO: 7), classified in class 435, subclass 6.

Inventions 7-12 are drawn to methods utilizing polynucleotides encoding diseases associated kinases having different structures. Therefore, each DAPK is patentably distinct one from the other. If any one of Inventions 7-12 is elected, the examination of the claims will be carried out only in-so-far as the claims are drawn to the elected subject matter.

SET 3:

13. Claims 11 and 12, drawn to a method for detecting molecules that bind to polynucleotide encoding DAPK-1 (SEQ ID NO: 1), classified in class 435, subclass 7.1.

14. Claims 11 and 12, drawn to a method for detecting molecules that bind to polynucleotide encoding DAPK-2 (SEQ ID NO: 2), classified in class 435, subclass 7.1.

15. Claims 11 and 12, drawn to a method for detecting molecules that bind to polynucleotide encoding DAPK-4 (SEQ ID NO: 4), classified in class 435, subclass 7.1.

16. Claims 11 and 12, drawn to a method for detecting molecules that bind to polynucleotide encoding DAPK-5 (SEQ ID NO: 5), classified in class 435, subclass 7.1.

17. Claims 11 and 12, drawn to a method for detecting molecules that bind to polynucleotide encoding DAPK-6 (SEQ ID NO: 6), classified in class 435, subclass 7.1.

18. Claims 11 and 12, drawn to a method for detecting molecules that bind to polynucleotide encoding DAPK-7 (SEQ ID NO: 7), classified in class 435, subclass 7.1.

Inventions 13-18 are drawn to methods utilizing polynucleotides encoding diseases associated kinases having different structures. Therefore, each DAPK is patentably distinct one from the other. If any one of Inventions 13-18 is elected, the examination of the claims will be carried out only in-so-far as the claims are drawn to the elected subject matter.

SET 4:

19. Claim 13, drawn to DAPK-1 (SEQ ID NO: 1), classified in class 435, subclass 183.

20. Claim 13, drawn to DAPK-2 (SEQ ID NO: 2), classified in class 435, subclass 183.

21. Claim 13, drawn to DAPK-4 (SEQ ID NO: 4), classified in class 435, subclass 183.

22. Claim 13, drawn to DAPK-5 (SEQ ID NO: 5), classified in class 435, subclass 183.

23. Claim 13, drawn to DAPK-6 (SEQ ID NO: 6), classified in class 435, subclass 183.

24. Claim 13, drawn to DAPK-7 (SEQ ID NO: 7), classified in class 435, subclass 183.

Inventions 19-24 are drawn to diseases associated kinases having different structures. Therefore, each DAPK is patentably distinct one from the other. If any one of Inventions 19-24 is elected, the examination of the claims will be carried out only in-so-far as the claims are drawn to the elected subject matter.

SET 5:

25. Claims 14-16 and 18, drawn to antibody against DAPK-1 (SEQ ID NO: 1), classified in class 530, subclass 388.26.

26. Claims 14-16 and 18, drawn to antibody against DAPK-2 (SEQ ID NO: 2), classified in class 530, subclass 388.26.

27. Claims 14-16 and 18, drawn to antibody against DAPK-4 (SEQ ID NO: 4), classified in class 530, subclass 388.26.

28. Claims 14-16 and 18, drawn to antibody against DAPK-5 (SEQ ID NO: 5), classified in class 530, subclass 388.26.

29. Claims 14-16 and 18, drawn to antibody against DAPK-6 (SEQ ID NO: 6), classified in class 530, subclass 388.26.

30. Claims 14-16 and 18, drawn to antibody against DAPK-7 (SEQ ID NO: 7), classified in class 530, subclass 388.26.

Inventions 25-30 are drawn to antibodies against diseases associated kinases having different structures. Therefore, each antibody against each DAPK is patentably distinct one from the other. If any one of Inventions 25-30 is elected, the examination of the claims will be carried out only in-so-far as the claims are drawn to the elected subject matter.

SET 6:

31. Claims 17 and 19, drawn to a method of diagnosing disease via the antibody against DAPK-1 (SEQ ID NO: 1), classified in class 435, subclass 7.1.

32. Claims 17 and 19, drawn to a method of diagnosing disease via the antibody against DAPK-2 (SEQ ID NO: 2), classified in class 435, subclass 7.1.

33. Claims 17 and 19, drawn to a method of diagnosing disease via the antibody against DAPK-4 (SEQ ID NO: 4), classified in class 435, subclass 7.1.

34. Claims 17 and 19, drawn to a method of diagnosing disease via the antibody against DAPK-5 (SEQ ID NO: 5), classified in class 435, subclass 7.1.

35. Claims 17 and 19, drawn to a method of diagnosing disease via the antibody against DAPK-6 (SEQ ID NO: 6), classified in class 435, subclass 7.1.

36. Claims 17 and 19, drawn to a method of diagnosing disease via the antibody against DAPK-7 (SEQ ID NO: 7), classified in class 435, subclass 7.1.

Inventions 31-36 are drawn to methods using antibodies against diseases associated kinases having different structures. Therefore, each antibody against each DAPK is patentably distinct one from the other. If any one of Inventions 31-36 is elected, the examination of the claims will be carried out only in-so-far as the claims are drawn to the elected subject matter.

SET 7:

37. Claims 20 and 21, drawn to a method of detecting/purifying a DAPK via the antibody against DAPK-1 (SEQ ID NO: 1), classified in class 435, subclass 7.1.

38. Claims 20 and 21, drawn to a method of detecting/purifying a DAPK via the antibody against DAPK-2 (SEQ ID NO: 2), classified in class 435, subclass 7.1.

39. Claims 20 and 21, drawn to a method of detecting/purifying a DAPK via the antibody against DAPK-4 (SEQ ID NO: 4), classified in class 435, subclass 7.1.

40. Claims 20 and 21, drawn to a method of detecting/purifying a DAPK via the antibody against DAPK-5 (SEQ ID NO: 5), classified in class 435, subclass 7.1.

41. Claims 20 and 21, drawn to a method of detecting/purifying a DAPK via the antibody against DAPK-6 (SEQ ID NO: 6), classified in class 435, subclass 7.1.

42. Claims 20 and 21, drawn to a method of detecting/purifying a DAPK via the antibody against DAPK-7 (SEQ ID NO: 7), classified in class 435, subclass 7.1.

Inventions 37-42 are drawn to methods using antibodies against diseases associated kinases having different structures. Therefore, each antibody against each DAPK is patentably distinct one from the other. If any one of Inventions 37-42 is elected, the examination of the claims will be carried out only in-so-far as the claims are drawn to the elected subject matter.

The inventions are distinct, each from the other because:

The nucleic acids of the Inventions of SET 1 are related to the protein of the Inventions of SET 4 by virtue of encoding same. The DNA molecule has utility for the recombinant production of the protein in a host cell, as recited in the Claims of Invention I. Although the DNA molecule and protein are related since the DNA encodes the specifically claimed protein, they are distinct inventions because the protein product can be made by another and materially different process, such as by synthetic peptide synthesis or purification from the natural source. Further, the DNA may be used for

processes other than the production of the protein, such as nucleic acid hybridization assay.

The nucleic acid of the Inventions of SET 1 and the antibody of the Inventions of SET 5 are related by virtue of the protein that is encoded by the nucleic acid and necessary for the production of the antibody. However, the nucleic acid itself is not necessary for antibody production and both are wholly different compounds having different compositions and functions. Therefore, these Inventions are distinct.

The proteins of the Inventions of SET 4 are related to the antibodies of the Inventions of SET 5 by virtue of being the cognate antigen, necessary for the production of antibodies. Although the protein and antibody are related due to the necessary stearic complementarity of the two, they are distinct Inventions because the protein can be used in another and materially different process from the use for the production of the antibody, such as in a pharmaceutical composition in its own right, or to assay or purify the natural ligand of the protein (if the protein is itself a receptor), or in assays for the identification of agonists or antagonists of the receptor protein.

The Inventions of SET 1 and the Inventions of SET 2 or SET 3 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product claimed can be used in a materially different process such as in either the Inventions of SET 2 or of SET 3 or to make proteins recombinantly, for example.

The Inventions of SET 5 and the Inventions of SET 6 or SET 7 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product claimed can be used in a materially different process such as in either the Inventions of SET 6 or of SET 7, for example.

The protein of the Inventions of SET 4 are not used in the methods of Inventions of SET 2, SET 3, Set 6, or SET 7 and therefore Inventions of SET 4 are distinct from Inventions of SET 2, SET 3, Set 6, or SET 7.

The nucleic acids of the Inventions of SET 1 are not used in the methods of Inventions of Set 6 or SET 7 and therefore Inventions of SET 1 are distinct from Inventions of Set 6 or SET 7.

The antibody of the Inventions of SET 5 are not used in the methods of Inventions of SET 2 or SET 3 and therefore Inventions of SET 5 are distinct from Inventions of SET 2 or SET 3.

The methods of Inventions of SET 2 and SET 3 are related in that each requires the use of the product of the Inventions of SET 1. However, the method steps and end points are wholly different and therefore these methods are patentably distinct.

The methods of Inventions of SET 6 and SET 7 are related in that each requires the use of the product of the Inventions of SET 5. However, the method steps and end points are wholly different and therefore these methods are patentably distinct.

The methods of Inventions of SET 2 and SET 3 are require different products and/or method steps from the methods of Inventions of SET 6 and SET 7 and are therefore patentably distinct one from the other.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Cochrane Carlson, Ph.D. whose telephone number is 703-308-0034. The examiner can normally be reached on 7:00 AM - 4:00 PM, off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Christopher Low can be reached on 703-308-2329. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

Karen Cochrane Carlson PhD

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July 16, 2002

KAREN COCHRANE CARLSON, PH.D
PRIMARY EXAMINER